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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/396,612
Filing Date: September 15, 1999
Appellant(s): STEVENS ET AL.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6, 2006 appealing from the Office action mailed December 9, 2002.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.
(Comcast Cable Holdings, LLC)

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.
(Claims 1-8 and 10 are pending, rejected, and appealed.)
(Claim 9 has been cancelled.)
(Claims 11-23 remain pending, but stand withdrawn.)

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (An after-final amendment was filed on April 3, 2003, and was entered.)

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is substantially correct. The changes are as follows:

I. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. (US 5,664,110).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

I. The rejection under 35 U.S.C. 102(e) as being anticipated by Kenney (US 6,026,376) has been withdrawn.

II. The rejection under 35 U.S.C. 102(e) as being anticipated by Petrovich et al. (US 6,101,483) has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 5,664,110 Green et al. 9/1997

(9) Grounds of Rejection

Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. (US 5,664,110).

Regarding claim 1, Green et al. disclose a method for automating the management of an inventory of consumer items (col. 13 line 5-9) at a consumer location using a programmed device (10, DPU, Fig. 1) accepting input data and executing instructions for automating inventory management (see abstract), the method comprising: receiving a series of shopping lists, each shopping list including at least one item (col. 7 line 1-20, Fig. 3); establishing a shopping list trend based on the series of shopping lists (col. 9 line 38-41, frequently ordered items establishes a list trend, col. 12 line 25-27, user buying patterns established); generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list (col. 10 line 1+, options list is the result of a suggested list (i.e., predicted) from the merchant or user); receiving a plurality of item price lists from a corresponding plurality of shopping locations (col. 11 line 24-34, there are multiple merchant databases (14, Fig. 2) thus multiple shopping locations); and recommending a shopping location based on the plurality of item price lists and the output list (col. 10 line 30-41, interpreted that the system determines which of the merchants to order from and displays this on DPU, see Figs. 6-7).

Regarding claim 2, in the method of Green et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; storing information indicative of the shopping list on a data storage medium; and, thereafter, retrieving the information from the data storage medium (col. 10 line 59-67).

Regarding claim 3, in the method of Green et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; sending information indicative of the shopping list over a network; and, receiving the information from the network (col. 11 line 20-45, see Fig. 1).

Regarding claim 4, the method of Green et al. further comprises: receiving at least one consumed item list including at least one item that has been consumed, wherein the shopping list trend is further based on the at least one consumed item list (col. 7 line 1-12, one list can be the basis for several lists, presumed that list items are to replace consumed items).

Regarding claim 5, in the method of Green et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof, the item having a tag and the item being identified by recognizing the tag (col. 7 line 49-55, items are added to the list by scanning the product code, i.e., a tag).

Regarding claim 6, in the method of Green et al., the tag is a bar code and the tag is recognized by scanning the bar code (col. 7 line 49-55, items are added to the list by scanning the product code, i.e., typically a bar code, see Fig. 2).

Regarding claim 7, in the method of Green et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof by recognizing the item with a camera (optical scanning wand 20 could be a camera).

Regarding claim 8, the method of Green et al. further comprises: comparing the output list with the next shopping list; and, modifying the shopping list trend based on the comparison (user can modify shopping list to create a custom list based on a variety of parameters, col. 10 line 5-6).

Regarding claim 10, in the method of Green et al., generating the output list further comprises: receiving an item list for a recipe; and, generating the output list further based on the item list for the recipe (received input items could be for any use, including a recipe, and output is based on the input).

(10) Response to Argument

As suggested by the panel remand dated November 11, 2006, the examiner has considered the question of patentability of the claims under 35 U.S.C. 101. The examiner considers the claims to be proper as presented with regard to this issue.

Regarding appellant's argument that Green et al. disclose neither "establishing a shopping list trend," nor "generating an output list in accordance with the shopping list trend," Green et al. indeed disclose these features. See, in particular, column 3, lines 45-63, and the references therein to items that are "regularly ordered" (lines 54-58),

which regularly ordered items a user can conveniently "incorporate into an order list currently being constructed" (lines 52-53).

Regarding the argument that Green et al. fail to disclose certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., performing the method steps in an automated fashion by means of a machine) are not recited in the rejected claim(s). Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case, all of the recited steps/functionality can be performed manually or mentally, without any machine, and the few claim recitations directed to any apparatus at all (i.e., things) utilized in the method steps are so broad as to read on far more than appellant's disclosed invention. For example, "a data storage medium," as recited in claim 2 (the first recitation of any apparatus in the body of the claims) reads on merely a slip/scrap of paper on which one could "store information" (jot down some notes, such as a grocery list, and "retrieve information" (read the notes). Other recitations, such as "over a network" in claim 3, may involve apparatus (such as making a phone call over a telephone network), or may not involve apparatus at all (since a network could be a group of people, such as a family, and sending information over the network could be simply a mom telling her son to tell his dad to pick up some milk at the store).

(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Christopher R Buchanan/

Examiner, Art Unit 3627

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

/Vincent Millin/

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Appeals Practice Specialist

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